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SUBJECT: Response

Serial No.: U.S. Patent Application 10/667,252, filed September 19, 2003

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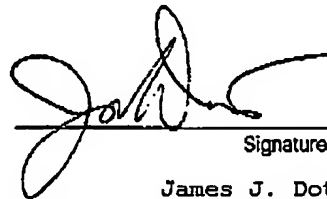
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 24935D	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>11/7/06</u></p> <p>Signature <u>Jan Hostasa</u></p> <p>Typed or printed name <u>Jan Hostasa</u></p>		Application Number 10/667,252	Filed September 19, 2003
		First Named Inventor Jones	
		Art Unit 3671	Examiner Addie, Raymond W.
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>40,360</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input checked="" type="checkbox"/> Total of <u>1</u> forms are submitted.</p>			

  
SignatureJames J. Dottavio  
Typed or printed name740/321-7167  
Telephone number11-7-06

Date

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
David R. Jones, IV et al.	)	Group Art Unit: 3671
	)	
Serial No.: 10/667,252	)	Examiner: Raymond W. Addie
	)	
Filed: September 19, 2003	)	Attorney Docket: 24935D
	)	
For: Mats For Use In Paved Surfaces	)	Confirmation No.: 1138

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Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**ARGUMENTS ACCOMPANYING REQUEST FOR**  
**PRE-APPEAL BRIEF CONFERENCE**

Honorable Sir:

Pursuant to the procedure specified in the Notice published in the Official Gazette on July 12, 2005, a pre-appeal brief conference is requested in the present application for the following reasons.

Claims 19, 22, 43 and 44 are pending in the application and were finally rejected in the Office Action mailed July 10, 2006. For the reasons described below, Applicants respectfully submit that the rejection includes clear errors and that it lacks essential elements required to establish a prima facie rejection.

**A. Rejection Includes Clear Errors.**

**1. Citation of Incorrect Law**

The Examiner erred in arguing that the structure and properties of the mat used in the claimed method do not afford patentable weight to the method claims, citing *Ex parte Pfeiffer* and *Ex parte Kangas* for the proposition that in order to be entitled to weight in method claims, the recited structural limitations (properties) therein must affect the method in a manipulative sense and not amount to the mere claiming of a use of a particular structure. Applicants respectfully submit that this is not a correct statement of the law.

The correct law is that the structure and properties of the mat and the result obtained by the method must be considered along with the method steps in determining patentability of the claimed method. The CAFC has stated that the materials used in a claimed process as well as the result obtained therefrom must be considered along with the specific nature of the process in determining patentability. *In re Dillon*, CAFC, 16 USPQ2d 1897 in paragraph [8] (1990). The CAFC has also stated that the test of obviousness requires that one compare the claim's subject matter as a whole with the prior art, finding that the starting material used in a claimed process imparted patentability to the claim. *In re Ochiai*, CAFC, 37 USPQ2d 1127 in paragraph [1] and the first paragraph of the analysis (1995).

Structural or material limitations in method or process claims are particularly entitled to patentable weight when they somehow affect or form an essential part of the method or process. See, for example, *Gottschalk v. Benson*, 175 USPQ at 677 (CCPA 1972), *In re Waldbaum*, 194 USPQ at 469 (CCPA 1977), and *In re de Castelet*, 195 USPQ at 47 (CCPA 1977). In the present application, the structure and properties of the mat used in the method are important to the method achieving the desired results.

It should be noted that *Ex parte Pfeiffer* and *Ex parte Kangas* are both decisions by the Board of Patent Appeals and Interferences, not court cases, and they are both very old decisions (1961). A search of the USPQ's indicates that *Pfeiffer* was never

cited as authority in any subsequent decisions or cases, and that Kangas was cited only by Pfeiffer for the argument asserted by the Examiner, and cited by two other decisions and one case for different propositions. It is submitted that Pfeiffer and Kangas do not correctly state the current law.

2. Incorrect Disregard of Representative Test Method

Regarding the shrinkage resistance of the mat recited in claim 43, the Examiner argued that the performance of a 4 ounce sample in an oven at 325°F does not appear relevant to a large reinforcement mat that is applied to a tack coat of liquefied asphalt. Applicants respectfully disagree. The oven temperature of 325°F is representative of the temperature at which a hot paving material is applied over a reinforcement mat. Also, it is a common practice to test for physical properties of an object by using a smaller sample of the object instead of the entire object, especially when the object is large so that testing the entire object would be impractical. Since the materials and structure of the mat are consistent throughout the mat, testing a portion of the mat for resistance to shrinkage is a representative test for the entire mat. Please refer to pages 9 and 10 of the Amendment filed September 7, 2006, for additional related arguments.

B. Rejection Lacks Essential Elements Required to Establish Prima Facie Rejection.

Claims 19, 22, 43 and 44 were rejected under 35 U.S.C. 103(a) as being unpatentable over Shah et al. (U.S. Pat. No. 4,637,946) in view of Gallagher et al. (U.S. Pat. No. 5,869,413).

1. Shah et al. Fails to Disclose the Claimed Mat.

The claims recite a nonwoven mat produced from a mixture of mineral fibers and polymer fibers. The Examiner stated that Shah et al. discloses a mat comprising a layer of polymer fillers and nonwoven mineral fibers, such as glass fibers integrated together. However, this is incorrect. Shah et al. discloses a 100% glass fiber mat. The mat then is impregnated with a blend of asphalt, block copolymer and mineral filler to produce the membrane. This structure is fundamentally different from the claimed mat structure. Please refer to page 5 of the Amendment filed September 7, 2006, for additional related arguments.

2. Gallagher et al. Also Fails to Disclose the Claimed Mat.

Gallagher et al. does not disclose a mat produced from a mixture of mineral fibers and polymer fibers, but rather it discloses a mat produced from a mixture of glass fibers and asphalt fibers. Persons of ordinary skill in the art would clearly view Gallagher et al. as teaching asphalt fibers, not polymer fibers, because the fibers are called "asphalt fibers" in the patent and they contain 70-98% asphalt. Please refer to pages 5 - 7 of the Amendment filed September 7, 2006, for additional related arguments.

The claims recite a mat produced from a mixture of mineral fibers and polymer fibers having a melting point above 330°F. The asphalt fibers disclosed in Gallagher et al. do not have a melting point above 330°F; Examples II, III and IV of the patent disclose asphalt fibers having softening points of 285°F, 244°F and 302°F. Please refer to pages 6 and 7 of the Amendment filed September 7, 2006, for additional related arguments.

The claims recite a mat having a load-elongation behavior such that the mat achieves at least 90% of its ultimate load at an elongation not greater than 5% of the mat length in the direction of applied tensile stress. There is no suggestion in Gallagher et al. of the elongation properties of the mat produced from a mixture of glass fibers and asphalt fibers.

3. There Is No Motivation to Combine Shah et al. and Gallagher et al.

At col. 2, lines 20-48, Shah et al. states that it is critical for the invention that the membrane has a low modulus of elasticity, and that this low modulus is achieved by the use of the glass fiber mat impregnated with a binder containing asphalt, a minor amount of block copolymer, and a filler. Thus, the glass fiber mat in Shah et al. is said to be critical to achieving the purpose of the invention. Clearly, there would be no motivation to replace the glass fiber mat of Shah et al. with the Gallagher et al. mat made from a mixture of glass fibers and asphalt fibers. To make this combination would be contrary to the purpose of the Shah et al. invention.

4. Even If Combined, Shah et al. and Gallagher et al. Are Different from the Claimed invention.

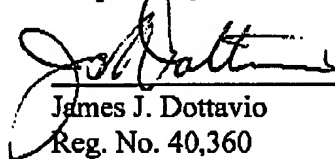
As discussed above, the combined teachings of Shah et al. and Gallagher et al. would not produce a mat from a mixture of mineral fibers and polymer fibers. They would not produce a mat made with polymer fibers having a melting point above 330°F. They do not suggest producing a mat having the claimed elongation properties.

5. Claim 43 Is Further Distinguishable.

Claim 43 states that the mat is resistant to shrinkage as measured by a particular defined test. The use of high melting point fibers forms a mat having this shrinkage resistance; both the polymer fibers and the mineral fibers have a melting point above 330°F. The asphalt fibers disclosed in Gallagher et al. have a melting point below 330°F, so a mat produced from these fibers would not pass the claimed shrinkage resistance test.

In view of the foregoing reasons, Applicants respectfully request reversal of the rejection and allowance of the pending claims.

Respectfully submitted,



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Date: November 7, 2006